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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/149,718 09/08/98 GAMES

K ANS-101-CIP(

EXAMINER

HM22/0925

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ART UNIT

PAPER NUMBER

1632

DATE MAILED:

09/25/01

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.

09/149,718

Applicant(s)

McConlogue et al.

Examiner

Deborah Crouch

Art Unit

1632



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED _____ FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on Aug 2, 2001. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☐ they raise the issue of new matter. (See NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

4. ☒ Applicant's reply has overcome the following rejection(s):
103 over Games et al.
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
see attachment.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
Claim(s) allowed: None
Claim(s) objected to: None
Claim(s) rejected: 1-20, 22, 26, 29-55, 57, and 58
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
11. ☐ Other: _____

DEBORAH CROUCH
PRIMARY EXAMINER
ART UNIT 1632

The claims are drawn to methods of testing compounds for an effect on an Alzheimer's Disease marker comprising administering the compound to a transgenic mouse or cells from the mouse, wherein the mouse has a nucleic acid construct incorporated into its genome, wherein the construct comprises a promoter operatively linked to a region encoding an A β -containing protein.

Regarding the response after final filed August 2, 2001.

I. Obviousness-type Double Patenting Rejections and Related Rejections.

The double patenting rejection over US Patent 5,811,633 and 5,720,936 is maintained as the scope of the claims in these patents is broader than that which is disclaimed. The claims in '633 encompass more than "exons 1-6 and 9-18 and genomic APP sequences encoding introns 6,7 and 8, and exons 7 and 8." The "same invention" rejection remains for these same reasons. The showings under 37 CFR § 1.78(c) and 35 USC § 1.32 remains for the same reasons.

The double patenting rejection over US Patent 5,612,486 and 5,604,102 is maintained as the transgenic mice of the claims are claimed to contain a nucleic acid construct that falls within the scope of the instant claims. As the structures are the same, the mice of '486 and '102 would exhibit the same phenotypes as the instantly claimed mice.

II. 102(b) rejections

These rejections are maintained as the nucleic acid constructs of the transgenic mice disclosed in WO 95/11968 and WO 93/14200 are contained within the scope of the transgenic mice of the claims. If the nucleic acid constructs of the mice in '11968 and '14200 are the same, then the phenotypes of the mice would inherently be as those mice instantly claimed. The artisan would have believed that identical nucleic acid structures, such as those of the mice of '11968 and '14200, would have led to the claimed phenotypes. There is no reason to believe otherwise. Applicant has not argued that the identical structures of '11968 and '14200 are not found in the instant claims.

III. 102(e)

The 102(e) rejection over US Patent 5,720,936 is maintained as the scope of the claims in this patent is broader than that which is disclaimed. The claims in '633 encompass more than "exons 1-6 and 9-18 and genomic APP sequences encoding introns 6,7 and 8, and exons 7 and 8."

The 102(e) rejection over US Patent 5,604,102 is maintained as the transgenic mice of the claims are claimed to contain a nucleic acid construct that falls within the scope of the instant claims. As the structures are the same, the mice of 102 would exhibit the same phenotypes as the instantly claimed mice.

III. 102(f) rejections

The 102(f) rejection over US Patent 5,720,936 is maintained for reasons of record. The scope of the mice of the present claims is disclosed in '936.

The 102(f) rejection over US Patent 5,604,102 is maintained for reasons of record. The scope of the mice of the present claims is disclosed in '936

IV. 103 rejections

The 103 rejection over Games et al is overcome by applicant's amendment.

The 103 rejection over US Patent 5,811,633 is maintained as the scope of the claims in these patents is broader than that which is disclaimed. The claims in '633 encompass more than "exons 1-6 and 9-18 and genomic APP sequences encoding introns 6,7 and 8, and exons 7 and 8."

The 103 rejection over 5,612,486 is maintained for reasons of record. Applicant has not argued what is missing from the art that removes it as an obviousness rejection. The mice of '486 are encompassed by the instant claims, and the specification of '486 teaches that the mice can be used in screening assays.

V. Enablement

The enablement rejection is maintained for reasons of record. As stated in the arguments of record, the achieving of Congo red staining plaques was unpredictable at the time of filing. Applicant has shown only one scope of the claimed mice which demonstrate such staining. The limitation of the claims is drawn to this.